

<sup>15</sup>  
[67]~~36~~<sup>12</sup>. (Amended) The computer system of claim [64]~~33~~ wherein the indication is a transmit complete signal.

<sup>16</sup>  
[68]~~37~~<sup>12</sup>. (Amended) The computer system of claim [64]~~33~~ wherein the bus controller monitors transmit of the data network events while data is being transmitted over the physical link of the data network.

<sup>17</sup>  
[69]~~38~~<sup>12</sup>. (Amended) The computer system of claim [64]~~33~~ wherein the bus controller includes a storage medium in which a statistical history compiled by the bus controller is maintained.

#### REMARKS

Claims pending in the instant application have been renumbered to 22-38 as suggested by the Examiner. Claims 22-38 presently stand rejected. Claims 22-38 have been amended. Applicants respectfully request reconsideration of the application in view of the amendments and the following remarks.

#### *Newly Executed Declaration Not Required*

In the December 9, 1999 Office Action, it is stated that the instant application was filed as a regular application and not as a continuation application as stated by the Applicants in the preliminary amendment filed June 17, 1999. The Office Action directs attention to the Applicants' declaration and the Office Action states that a new declaration is required.

The Applicants respectfully traverse this position and submit that a new declaration is not required. Attention is directed to 37 C.F.R. § 1.63(d) as well as M.P.E.P. § 201.06(c). As stated in M.P.E.P § 201.06(c):

37 CFR 1.63(d) provides that a newly executed oath or declaration is not required in a continuation or divisional application filed by all or by fewer than all of the inventors named in a prior nonprovisional application containing a signed oath or declaration as required by 37 CFR 1.63, provided that a copy of the signed oath or declaration filed in the prior application is submitted for the continuation or divisional application and the specification and drawings filed in the continuation or divisional application do not contain any subject matter that would have been new matter in the prior application.

The Applicants filed the present application as a continuation of application serial no. 08/526,714, filed September 11, 1995, pursuant to 37 C.F.R. §§ 1.53(b) and 1.63(d). When filing the present continuation application, the claim for priority was made in the transmittal letter and was repeated in the preliminary amendment. True copies of the originally filed specification and drawings and a true copy of the originally executed declaration were included. Additional copies of these documents, which have already been submitted with the present continuation application during filing, can be provided upon request. Therefore, since the Applicants meet the requirements of 37 C.F.R. § 1.63(d), a newly executed declaration is not necessary for the instant application to be a continuation application.

*Missing Reference to Parent Application*

In the December 9, 1999 Office Action, it is brought to the Applicants' attention the present continuation application is missing a reference to the parent

application. The Applicants have amended the specification to provide this information accordingly.

#### *Renumbering of Claims*

In the December 9, 1999 Office Action, it is brought to the Applicants' attention the claims of the present continuation application should be renumbered from 53-69, as introduced in the preliminary amendment, to 22-38. The Applicants have amended the claims and dependencies as suggested.

#### *35 USC § 112 Rejection of Claims*

In the December 9, 1999 Office Action, claims 24-32 and 37-38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

In particular, the Office Action states that claims 24-25 contradict with parent claim 22, which indicates that a frame of data has been transmitted. Exemplary claim 22 as presently amended recites that data to be transmitted from a main memory in a host computer is copied into a buffer memory in a network controller from the main memory of the host computer. Data is transmitted from the buffer memory over a physical link of a data network in response to a threshold quantity of data having been copied into the buffer memory from the main memory. An indication is provided to the host computer that a frame of data has been successfully transmitted from the buffer memory over the physical link of the data network prior to the frame of data being completely transmitted from the buffer memory over the physical link. Claim 24 recites that threshold quantity of data is less than a frame of data and claim 25 recites that the threshold quantity of data is greater than a frame of data.

In sum, claims 24 and 25 recite that the threshold quantity of data may be either less than or greater than a frame of data, respectively. Data begins to be transmitted out from the buffer memory over the physical link in response to the threshold quantity of data having been copied into the buffer memory from the main memory. The indication that the frame of data has been successfully transmitted out from the buffer memory is provided prior to the frame of data having been completely transferred from the buffer memory over the physical link. Therefore, the Applicants respectfully submit that presently amended claims 24 and 25 do not contradict presently amended claim 22.

The December 9, 1999 Office Action also states that claims 26-27, 31-32 and 37-38 are vague and indefinite in that it is not clear what the controller is monitoring. To expedite a timely allowance of the present application, claims 26, 31 and 37 have been amended to clarify that the recited transmit events are transmit events of the data network.

The December 9, 1999 Office Action indicates that claim 28 is vague and indefinite in that it is not clear what direction data is transmitted. Claim 28 as presently amended recites that the controller provides to the host computer the indication of successful frame transmission from the buffer memory over the physical link.

Thus, the Applicants respectfully submit that the instant section 112 rejections have been overcome.

*35 USC § 101 Statutory Type Double Patenting Rejection*

In the December 9, 1999 Office Action, claims 22-38 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-11 of US Patent No. 5,944,804 (the '804 patent). As remarked in the Office Action, the term "same invention" in the context of a statutory type double patenting rejection under 35 U.S.C. § 101 means an invention drawn to *identical subject matter*.

Claim 1 of the '804 patent includes the limitations of "copying data to be transmitted from a main memory . . . *while unallocated buffer memory locations remain available*," and "providing an indication to the host computer . . . *when the frame of data has been merely copied to the buffer memory*." Presently amended claim 22 does not include these limitations.

Claim 7 of the '804 patent includes the limitations of "a controller, to initiate transmission of data over a physical link once a threshold quantity of data has been copied into the buffer memory from a *communicatively* coupled host computer, and to provide an indication to the host computer . . . *when a predetermined quantity of data has been merely copied to the buffer memory*." Presently amended claim 28 does not include these limitations.

Presently amended claim 33 recites a CPU, a bus, a main memory coupled to the bus and a bus controller coupled between the bus and the physical link. The claims of the '804 do not include these limitations.

Thus, the presently amended claims and the claims of the '804 patent are not drawn to *identical* subject matter since the claims of the present application

and the '804 patent do include the same limitations and are therefore not coextensive in scope. Accordingly, the Applicants respectfully submit that the instant 35 U.S.C. § 101 statutory double patenting rejection has been overcome.

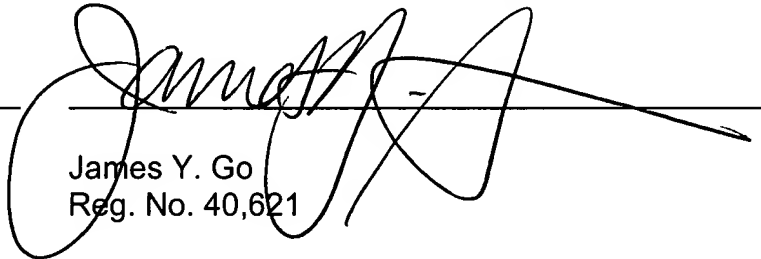
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Respectfully submitted,

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Date: 1-5-2000

  
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